

TTAB

78436807

16-0221

10/16/2006 10:08:06 AM

01 FC:6483

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Fabric Editions LCC, F/DA FE
ACQUISITION, LLC
Serial No.: 78/436,807
Filing Date: 06/17/2004
Mark: FABRIC PALETTE (and design)
International Class: 024 (as reclassified)
Law Office No.: 108
Examining Attorney: Amos T. Matthews
Attorney's Docket No.: FAB/TM-18

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner refusing registration of the above-identified mark.

A check in the amount of \$100.00 is enclosed to cover the fee due in connection with the filing of this Notice of Appeal.

In the event that any additional fees may be due in connection with the filing of this Notice, please charge the cost of the same, or credit any overpayment, to Deposit Account No. 16-0221.

Thank you.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VA 22313-1451, ON:

October 3, 2006
(DATE OF DEPOSIT)

Mark J. Pandiscio
(NAME OF ATTORNEY)

Mark J. Pandiscio 10/3/06
(SIGNATURE)

October 3, 2006
(DATE OF SIGNATURE)

Respectfully submitted,

Mark J. Pandiscio 10/3/06

Mark J. Pandiscio
Registration No. 30,883
Pandiscio & Pandiscio, P.C.
470 Totten Pond Road
Waltham, MA 02154
Tel (781) 290-0060
Fax (781) 290-4840

MMS/FABTM18.APL

FAB/TM-18

10-10-2006
U.S. Patent & TMOc/TM Mail Rpt Dt. #72

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Fabric Editions LCC, F/K/A FE
 ACQUISITION, LLC

Serial No.: 78/436,807

Filing Date: 06/17/2004

Mark: FABRIC PALETTE (and design)

International Class: 024 (as reclassified)

Law Office No.: 108

Examining Attorney: Amos T. Matthews

Attorney's Docket No.: FAB/TM-18

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED
WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL,
POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO: COMMISSIONER
FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VA 22313-1451, ON:

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

October 3, 2006

(DATE OF DEPOSIT)

Mark J. Pandiscio

(NAME OF ATTORNEY)

Mark J. Pandiscio 10/3/06

(SIGNATURE)

October 3, 2006

(DATE OF SIGNATURE)

Sir:

RESPONSE

This is in response to the Official Action currently
outstanding with respect to the above-identified trademark
application.

FAB/TM-18

Remarks

In the outstanding Official Action, the Examining Attorney refused registration under Trademark Act Section 2(e)(1), 15 USC 1052(e)(1) because the subject matter for which registration is sought is merely descriptive of the identified goods.

Applicant respectfully disagrees with the Examining Attorney's conclusion that when the proposed mark is used in connection with the goods, it indicates that the fabrics are produced in a particular set of colors, and, as such, it is merely descriptive under Trademark Act Section 2(e)(1).

More particularly, Applicant notes that it is seeking to register the mark "FABRIC PALETTE (and design)" for "pre-cut cotton fabrics". Applicant is not seeking to register the mark "FABRIC PALETTE (and design)" for cloth in a particular set of colors. While Applicant appreciates that its "pre-cut cotton fabrics" may indeed have various colors Applicant notes that any product may have a variety of colors, and the color of the fabrics is not a defining feature of Applicant's goods. Instead, Applicant's goods are fabrics that are pre-cut so as to provide the customer with an easier sewing process. Since the word "fabric" refers to a cloth made by weaving, knitting or felting

fibers, and the word "palette" refers to "a board, typically with a hole for the thumb, which an artist can hold while painting and on which colors are mixed", or "the range of colors used in a particular painting or by a particular artist", the words "fabric palette" would generally describe an arrangement of colors of cloth or a board of cloth in a range of colors. The words "fabric" and "palette" do not refer to "pre-cut cotton fabrics".

Thus, Applicant believes that the Examining Attorney's suggestion that the proposed mark (FABRIC PALETTE and design) merely describes Applicant's goods (pre-cut cotton fabrics), on the grounds that the mark indicates that "the fabrics are produced in a particular set of colors", is erroneous in that the mark's meaning is derived metaphorically, not literally. In a general sense, a metaphor is a figure of speech in which a word or phrase that ordinarily designates one thing is used to designate another, thus making an implicit comparison. In a trademark sense, a metaphor (e.g., Applicant's mark) is an enormously valuable technique for creating a subtle suggestion of a concept (e.g., Applicant's goods).

Applicant also notes that, contrary to the Examining Attorney's indication that the mark does not consist of a design feature, the mark "FABRIC PALETTE" actually does consist of a design feature. As can be seen on the attached copy of the mark (including design), the design emphasizes the word "PALETTE". This is important to note because it further emphasizes Applicant's intent that the meaning of the mark be derived metaphorically and not literally.

Thus, it will be seen that the mark "FABRIC PALETTE (and design)" is not merely descriptive of Applicant's goods; rather, the mark is, at the most, simply suggestive of Applicant's goods. Imagination, thought or perception is necessary to reach a conclusion as to the nature of Applicant's goods in conjunction with the mark. Thus, Applicant's suggestive mark is not a descriptive mark (which immediately tells something about the goods or services). See TMEP 1209.01(a). Accordingly, reconsideration on this point is respectfully requested.

In view of the foregoing, Applicant submits that this application is now in condition for allowance. Early and favorable reconsideration is therefore respectfully solicited.

Respectfully submitted,

Mark J. Pandiscio 10/3/06

Mark J. Pandiscio

Registration No. 30,883

Pandiscio & Pandiscio, P.C.

470 Totten Pond Road

Waltham, MA 02451-1914

Tel (781) 290-0060

Fax (781) 290-4840

KT/FABTM18.AMD4

Fabric Palette